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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,102	02/23/2006	Roelof Marissen	4662-55	7740

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EXAMINER

CUMBERLEDGE, JERRY L

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/544,102

Applicant(s)

MARISSIN ET AL.

Examiner

Jerry Cumberledge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/09/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

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- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 11, applicant states "...running as part 0) from outside..." It is unclear what "part 0)" means.

In claim 1, line 3 applicant states "...having a first resp. second central hole..." It is unclear what this statement means. The statement will be treated as meaning that each plate has a respective first and second central hole.

In claim 1, lines 3-4, applicant states "...and a first resp. second ring..." It is unclear what this statement means. For examination purposes, the statement will be treated as meaning that each plate has a respective first and second ring.

In claim 1, line 4, applicant state "... [the] ring[s] surrounding said said first resp. second hole..." It is unclear what this statement means. For examination purposes, the

statement will be treated as meaning that each plate has a hole and each plate has a distinct ring surrounding each respective hole.

Claim 1 recites the limitation "its one end" in line 17. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "its other end" in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the other end" in lines 18-19. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation " the fixing rings" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin (US. Pat. 5,376,126).

Lin discloses a bone fixing device comprising a surgical cable (Fig. 1, ref. 62) having a first and a second end (Fig. 1) and at least a first (Fig. 1, ref. 10) and a second fixing plate (Fig. 1, ref. 40) having a first (Fig. 1, ref. 16) resp. second central hole (Fig. 1, ref. 41) and a first (Fig. 1, the surrounding edge of ref. 10) resp. second ring (Fig. 1,

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the surrounding edge of ref. 40) surrounding said first resp. second hole, the circumference of each fixing plate (the outer edges of ref. 10 and 40) forming an outer edge of its ring and an inner edge of its ring (the edges next to the holes in ref. 10 and 40) being adjacent to the hole it surrounds, the first fixing plate capable of being in a stacked position on top of the second plate leaving a gap between the plates and the holes at least partly overlapping each other, wherein at least one end of the cable is capable of following a continuous trajectory running from outside the outer edges underneath the second ring up to the second hole, bending upward into a first upward part (a) running through the second and the first holes a bend to an outward part (b) running across the first ring in the direction of its outer edge, a downward part (c) outside said outer edge running in a direction opposite to the upward part, a part (d) running through the hole of the second ring part (d) at its one end being connected to a trajectory part (e) running through the gap between the fixing plates and at its other end being connected to a trajectory part running underneath the second ring, the other end of the cable also being connected to the fixing plates (Fig. 1). Part (c) further runs outside the outer edge of the second ring and is connected to one end of part (d) through trajectory part (f) running underneath the second ring (12) from its outer edge to its hole and the other end of part (d) is immediately connected to part (e) running through the gap between the fixing plates in an outward direction and ending outside the plates in a cable end (Fig. 1, end of the cable). The trajectory parts are capable of being placed in the order (a), (b), (c), (e), (d), followed by trajectory part (g), which is capable of running underneath the second ring from the hole to the outer edge and

ending outside the plates in a cable end the end of (Fig 1 below). The other end of the cable (Fig. 1) is also capable of following one of said trajectories. The other end is fixed to a tensioning device (Fig. 2d, ref. 64) that is connected to the fixing rings (Fig. 2d and Fig. 2e). Lin further discloses a bar (Fig. 1, ref. 30).

Lin discloses a set of at least two fixing plates (Fig. 1, ref. 10 and 40) and a surgical cable (Fig. 1, ref. 62) fitted for constructing a bone fixing device according to claim 1. Fixing plate (Fig. 1, ref. 10) prepared for application in a bone-fixing device according to claim 1. Surgical cable (Fig. 1, ref. 62) prepared for application in a bone-fixing device according to claim 1. Set of at least two fixing plates (Fig. 1, ref. 10 and 40) and a surgical cable (Fig. 1, ref. 62) prepared for application in the method claim 6. Fixing plate (Fig. 1, ref. 10) prepared for application in the method of claim 6. Surgical cable (Fig. 1, ref. 62) prepared for application in the method of claim 6.

With regard to statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over the bone fixing device of Lin, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In claim 1, the following passages are being treated as functional language:

“...the holes at least partly overlapping each other, wherein at least one end of the cable following a continuous trajectory running as part 0) from outside the outer edges underneath the second ring up to the first hole, bending upward into a first upward part (a) running through the second and the first holes, a bend to an outward part (b) running across the first ring in the direction of its outer edge, a downward part (c) outside said outer edge running in a direction opposite to the upward part (a), a part (d) running through the hole of the second ring...running through the gap between the fixing plates...” The holes are capable of at least partly overlapping each other, if they are moved into a position to do so. The cable is capable of following a continuous trajectory as stated and bending to conform to the parts labeled part (a)-part (g). The parts labeled part(a) to part(g) (Fig. 1 below) are capable of being placed in the positions that are functionally recited in the above passages.



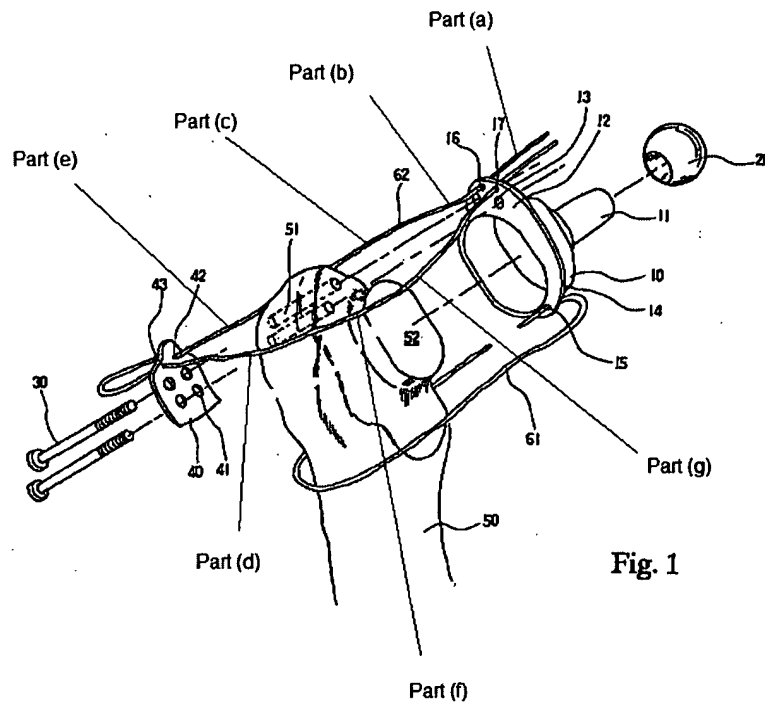


Fig. 1

The bone fixing device of Lin is capable of performing a method for fixing bone parts comprising the steps of applying a bone fixing device according to claim 1 around the bone parts to be fixed, followed by drawing the ends of the cable to tension the cable around the bone parts to the tension required to fix the bone parts. A bar is inserted between the fixing plates before the cable is tensioned and removed after the cable has been tensioned.

The bone fixing device of Lin is capable of performing a method for fixing bone parts comprising the steps of applying a bone fixing device according to claim 5 around the bone parts to be fixed, followed by drawing said one end of the cable to tension the

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cable around the bone and then tensioning the cable to the tension required to fix the bone parts by means of the tensioning device.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Cumberledge whose telephone number is (571) 272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLC

A handwritten signature in black ink, appearing to be 'JLC' with a stylized flourish.A handwritten signature in black ink, appearing to be 'Eduardo C. Robert' with a large, sweeping flourish.

EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER